



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : **Confirmation No. 4199**
Mikio YAMAHIRO et al. : Docket No. 2003-1318A
Serial No. 10/664,151 : Group Art Unit 1621
Filed September 17, 2003 : Examiner Samuel A. Barts

PRODUCTION PROCESS FOR
SILICON COMPOUND AND THE SAME : **Mail Stop Amendment**

RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

THE COMMISSIONER IS AUTHORIZED
TO CHARGE ANY DEFICIENCY IN THE
FEE FOR THIS PAPER TO DEPOSIT
ACCOUNT NO. 23-0975.

Sir:

Responsive to the Office Action of August 5, 2005 (the time for responding thereto being extended for one month in accordance with a Petition for Extension of Time submitted herewith), constituting a requirement for restriction between (I) claims 1-18, 22-32 and 38 and (II) claims 19-21 and 33-37, Applicants hereby elect, with traverse, the subject matter of claims 1-18, 22-32 and 38.

Applicants traverse the restriction requirement on the basis that the Examiner has merely stated that the product as claimed can be made by another and materially different process, without showing or demonstrating how this could be accomplished, as required by MPEP 806.05(f) cited by the Examiner. Note the references to "can be shown" and "if the examiner can demonstrate that the product as claimed can be made by another materially different process" in MPEP 806.05(f). Also note that form paragraph 8.18, for bracket 3 indicates that "the product as claimed can be made by a materially different process **such as**". Although MPEP 806.05(f) indicates that allegations of different processes or products need not be initially documented, it is apparent that this does not relieve the Examiner of the burden of showing or

demonstrating another process (other than the claimed process) by which the claimed compounds can be made. In the absence of such a showing, the restriction requirement should be withdrawn.

Furthermore, all of the claims in both Groups I and II are identically classified by the Examiner, i.e. in class 556, subclass 400+, thus indicating that searching both the process and the compounds would not be an undue burden on the Examiner.

The Office Action also constitutes a requirement for an election of a single disclosed species, in response to which Applicants elect, with traverse, the process of Example 45 beginning on page 93 of the specification.

Both of the foregoing elections are made while reserving Applicants' rights under 35 U.S.C. §121 to file a divisional application for the non-elected subject matter.

Action on the merits is requested.

Respectfully submitted,

Mikio YAMAHIRO et al.

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